

REMARKS

Applicant has carefully reviewed the Decision dated February 3, 2010. Applicant has amended Claim 1 to more clearly point out the present inventive concept. Claim 9 has been cancelled. Claims 1-7 and 10-14 are currently pending. Reconsideration and favorable action is respectfully requested.

The Decision of the Board of Patent Appeals and Interferences (BPAI) has reversed the rejection of Claims 1, 5, 7, 9-11 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini, Picco, and Harvey and of Claims 2, 3, 4, 6, 12, and 4 under 35 U.S.C. § 103(a) as being unpatentable over Tognazzini, Picco, Harvey, and McKiel, Jr. The BPAI has entered new grounds of rejection of Claims 1-7 and 9 under 35 U.S.C. § 112, second paragraph. Accordingly, Claims 10-14 are not currently rejected.

As described on page 24 of the BPAI Decision, the decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) which provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b)(1) provides that Applicant may respond to the new ground of rejection to reopening prosecution by “submit[ting] and appropriate amendment of the claims so rejected ..., and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner ...”

Pursuant to 37 C.F.R. § 41.50(b)(1), Applicant has amended Claim 1 to address the new 35 U.S.C. § 112, second paragraph rejection of the BPAI in order to reopen prosecution and have the matter reconsidered by the examiner. In the 35 U.S.C. § 112, second paragraph rejection, the BPAI asserted that the limitation in Claim 1 of “means for launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information” was indefinite. In particular, the BPAI construed the limitation as a “computer-enabled means-plus-function” limitation and asserted that the “Specification fails to disclose an algorithm corresponding to the recited function at issue in Claim 1 such that one of ordinary skill in the art could determine the

scope of Claim 1.” The Decision further asserted that Claims 2-7 are also indefinite because they depend from Claim 1. Claim 9 was rejected under 35 U.S.C. § 112, second paragraph because it depends on a cancelled claim. Claim 9 has been cancelled, thus rendering the rejection of Claim 9 moot.

Applicant has amended Claim 1 to remove the alleged “means-plus-function” language. In particular, Applicant has amended Claim 1 to change the phrase “means for launching said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information” to “a display program for displaying said decoded advertising content on said display of said computer under the control of said decoded control information substantially at the time of reception of the advertisement information.” Support for this amendment to Claim 1 may be found in at least page 16, lines 5-11; page 20, line 24 to page 21, line 17; and page 23, line 1-23 of the specification as originally filed. The cited portions of the specification describe an embodiment of a “display program” in the form of a “browser” for displaying decoded advertising content on a display of a computer under the control of decoded control information. Applicant respectfully submits that the meaning of Claim 1 as amended would be understood to one of ordinary skill in the art at the time the invention was made. In view of the foregoing amendment to Claim 1, Applicant submits that Claim 1 is not indefinite and requests that the 35 U.S.C. 112, second paragraph rejection of Claims 1-7 be withdrawn.

In view of the foregoing, Applicant respectfully submits that Claims 1-7 and 10-14 are allowable over the art of record.

Applicants have now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicants respectfully request full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/RPXC-24,736 of HOWISON & ARNOTT, L.L.P.

Respectfully submitted,
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